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OFFICE OF PETITIONS

In re Application of :
Liming Tsau : DECISION DISMISSING
Application No. 10/750,834 : PETITION
Filed: January 5, 2004 :
Attorney Docket No. 1875.023001/JDE :

This is a decision on the petition filed June 3, 2004, requesting that the above-identified application be accorded a filing date of January 5, 2004, with Figures 16A-19J as part of the original disclosure.

On January 5, 2004, applicant filed the above-identified application. On April 9, 2004, the Office mailed a "Notice of Omitted Item(s) in a Nonprovisional Application" (Notice), stating that the application was accorded a filing date of January 5, 2004; however, it appeared that Figures 16A-19J described in the specification were omitted.

In response, on June 3, 2004, applicant submitted, inter alia, the present petition, the petition fee, and copies of 13 sheets of drawings containing Figures 16A-19J.

Applicant admits that Figures 16A-19J were not submitted on filing the original application papers. However, applicant argues that these figures should not be considered omitted because they were incorporated by reference.

Upon review of the record, Figures 16A-19J have not been located in the official file. It is noted that the application transmittal letter identified this application as a continuation application of prior application No. 09/753,664, filed January 4, 2001, and specifically incorporated by reference the disclosure of the prior application.

Section 201.06(c) of the Manual of Patent Examining Procedure states that:

. . . an applicant may incorporate by reference the prior application by including, in the application-as-filed, a

statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied).

Obviously, in view of the incorporation by reference of Application No. 09/753,664, the drawings of Figures 16A-19J are not new matter if they were a part of the disclosure of Application No. 09/753,664. If applicant desires that Figures 16A-19J be added to the application, an amendment should be filed prior to the first action on the merits, which will be considered by the primary examiner.

Accordingly, the Notice mailed on April 9, 2004, was correct in stating that Figures 16A-19J described in the specification appeared to have been omitted. Therefore, the requirement for the omitted figures was proper and will not be withdrawn.

Accordingly, the petition is dismissed.

The \$130.00 petition fee will not be refunded because the petition was not necessitated by any error on the part of the United States Patent and Trademark Office.

The Office of Initial Patent Examination is directed to process the application with a filing date of January 5, 2004, using the application papers filed on that date. Figures 16A-19J will not be entered at this time.

Any inquiries related to this decision should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

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